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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/728,516

12/05/2003

Tracee Eidenschink

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9041

490 7590 11/17/2009  
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EXAMINER

TYSON, MELANIE RUANO

ART UNIT

PAPER NUMBER

3773

MAIL DATE

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11/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/728,516	<b>Applicant(s)</b> EIDENSCHINK ET AL.	
	<b>Examiner</b> MELANIE TYSON	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14,35-38 and 55-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14,35-38 and 55-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the applicant's amendment received on 22 December 2008 and arguments provided in the pre-appeal request received 07 August 2009. Claims 3, 15-34, and 39-54 remain canceled. New claims 56 and 57 were added. The amendments made to the claims 22 December 2008 do not place the application in condition for allowance for the reasons set forth below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 2, 4-14, 35-38, and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsudou et al. (U.S. Patent No. 7,029,492 B1) in view of Acosta et al. (U.S. Patent No. 7,137,993).**

Mitsudou discloses a stent (see entire document) comprising an expandable framework comprising a plurality of serpentine bands, adjacent bands connected by at least one permanent connector (81) extending from a valley of one band to the peak of the second band (for example, see Figure 21) and disengagable connector struts (4). Mitsudou suggests breaking the disengagable struts with an inflatable balloon in order to enable further expansion of desired locations and form open cells (for example, see Figure 23), but fails to disclose an electrical lead coupled to the disengagable struts to cause disengagement by electrolytic detachment.

Acosta discloses a plurality of bands that at least partially self-expand comprising disengagable struts (see entire document). Acosta teaches coupling an electrical lead to the disengagable struts to induce electrolytic detachment of the struts having reduced thickness portions (for example, see Figure 7) and inherently higher corrosion potential than the rest of the device (otherwise the entire device would corrode simultaneously destroying the device), wherein corrosion reduces the mass of the metal framework (see column 6, lines 18-40 for details). Thus, it would have been recognized by one of ordinary skill in the art that applying the known technique taught by Acosta to Mitsudou's device would have yielded predictable results and resulted in an improved system, namely, a system that would enable disengagement of the disengagable connectors at desired locations directly with electrical leads, thus eliminating the step of having to introduce a balloon into desired portions of the stent after the stent has been deployed.

With further respect to claim 12, the applicant has not disclosed that this configuration provides an advantage, is used for a particular purpose, or solves a stated problem, indicating the embodiments are obvious variations, and it appears the prior art configuration would perform equally well. Since one having ordinary skill in the art could have connected the disengagable struts to the bands at the necked portion of the disengagable struts and the applicant has not stated any benefit of doing so, it would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the disengagable struts to the bands at the necked portion of the disengagable struts as a matter of design choice.

### ***Response to Arguments***

Applicant's arguments filed 07 August 2009 with respect to the Mitsudou have been fully considered but they are not persuasive. The applicant argues that eliminating the step of having to introduce a balloon into the desired portions of the stent after the stent has been deployed to disengage the disengagable connector struts is not sufficient motivation to modify the Mitsudou reference, since a balloon must still be used to dilate the side branch opening. However, dilation of the side branch opening is not required. Mitsudou discloses the balloon is used to simply break the connection such that an opening is created to reduce the possibility of blocking flow into the branch vessel and further allow the insertion of other balloon catheters, blood vessel dilation devices, and stents through the opening and into the branched blood vessel if so desired (for example, see column 26, lines 43-51). Therefore, a mechanical detachment means is not required and thus it is the examiner's position that such a modification

would have been obvious to one having ordinary skill in the art at the time of the invention (see also new rejection above).

### ***Conclusion***

Applicant's amendment received 22 December 2008 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE TYSON whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./  
Examiner, Art Unit 3773  
November 10, 2009

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773